

REMARKS

Applicants appreciate the time taken by the Examiner to review Applicants' present application. This application has been carefully reviewed in light of the Official Action mailed November 2, 2005. Applicants respectfully request reconsideration and favorable action in this case.

Applicant appreciates the time and effort by the Examiner in reviewing this application. In the Action, the Examiner alleges that the application contains claims directed to two (2) patentably distinct inventions. Group I, Claims 11-14 and 27 drawn to a Demultiplexer, classified in class 340, subclass 536; and Group II, Claims 7-9 and 26, drawn to a Multiplexer, classified in class 340, subclass 537; and Claims 1-6, 10 and 15-25 link(s) inventions I and II. By the Action, Applicant is required under 35 U.S.C. 121 to elect a single disclosed invention for prosecution.

Accordingly, Applicant disagrees, at least in part, with the Examiner's reasoning for the election/restriction, but nevertheless hereby elects with traverse Group 1, Claims 11-14 and 27, drawn to a Demultiplexer, and Claims 1-6, 10 and 15-25 as linking claims between Group I and Group II. Applicant reserves the right to file Divisional applications on the non-elected invention.

Applicant respectfully traverses the Examiner's assertion that the application contains claims directed to two (2) patentably distinct inventions.

The applicant respectfully requests reconsideration of the election/restriction pursuant to 37 CFR § 1.143, provides the reasons therefore below, and provisionally elects Group I, Claims 11-14 and 27 and generic Claims 1-6, 10 and 15-25.

35 USC 112, fourth paragraph, states, in part, "a claim in dependent form shall contain ... a further limitation of the subject matter claimed ... [and] shall be construed to incorporate by reference all the limitations of the claim to which it refers".

In the present patent application, claims of Group I and Group II properly dependent from linking claims 1-6, 10 and 15-25, which corresponds to at least one disclosed embodiment of the invention. Thus, by definition, dependent claims of Group I and Group II provide

additional limitations to the at least one embodiment covered by the linking claims. As such, Claims of Group I and Group II are providing varying breadth and/or scope of definition of the at least one disclosed embodiment.

MPEP 806.03 states, in part, “where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition”. Accordingly, claims of Group I and Group II should not be subject to restriction since they are different definitions of the same disclosed subject matter of the linking claims, varying in breadth or scope of definition.

The applicant respectfully submits that a restriction of the claims based on the figures is inconsistent with 35 USC § 121, MPEP 806.04(e) and MPEP 2111. 35 USC § 121 states, in part, that “if two or more independent and distinct inventions are claimed in one application ...” MPEP 806.04(e) states, in part, that, “Claims may be restricted to a single disclosed embodiment (i.e., a single species, and thus be designated a *specific species claim*), or a claim may include two or more of the disclosed embodiments within the breadth and scope of definition (and thus be designated a *generic or genus claim*). *Species are always the specifically different embodiments*”. MPEP 2111 states, in part, that, “reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from ‘reading limitations of the specification into a claim,’ to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim.” The court found that applicant was advocating the latter, i.e., the impermissible importation of subject matter from the specification into the claim”.

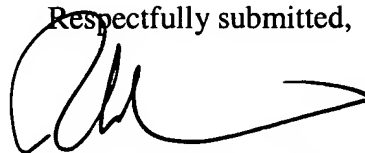
In particular, 35 USC § 121 and MPEP 806.04(e) indicate that if a restriction is applicable, it is the claims that are to be restricted, not the drawings. Further, the drawings are part of the specification, which, in accordance with MPEP 2111, may be use to interpret limitations explicitly recited in the claims, but not to provide limitations of the specification into the claims. Utilizing the figures to restrict the claims corresponds to providing limitations of the specification into the claims, which is not permitted by MPEP 2111. Accordingly, the restriction based on the figures is inappropriate and should therefore be withdrawn.

Applicant disagrees at least in part, with the Examiner's reasoning for a requirement to elect between Species I , Species II and Species III the election/restriction, but nevertheless hereby elects with traverse Species I

While Applicants believe no other fees are due with this transmission, if any fees are due, the Commissioner is hereby authorized to charge Deposit Account No. 50-2126 of Garlick, Harrison & Markison, LLP.

If the Examiner has any questions or comments, or if further clarification is required, it is requested that the Examiner contact the undersigned at the telephone number listed below. Please reference Attorney Docket No. BP2517.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. McLauchlan', with a long horizontal flourish extending to the right.

Robert A. McLauchlan
Reg. No. 44,924

Date: March 2, 2005

ATTORNEY FOR APPLICANTS

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AUSTRALIA

Patents Act 1990

NOTICE OF ENTITLEMENT

We, Lockheed Martin Corporation the applicant/nominated person in respect of Application No. 2002222956, state the following:-

The Nominated person is entitled to the grant of the patent because the Nominated person derives title to the invention from the inventor by assignment.

The Nominated person is entitled to claim priority from the application listed in the declaration under Article 8 of the PCT because the Nominated person made the application listed in the declaration under Article 8 of the PCT.

DATED this 31st day of May, 2005

Draft

**(A member of the firm of Davies Collison Cave for
and on behalf of the applicant)**



NOTIFICATION OF SEARCH RESULTS – Standard Patent Applications

Under Australian Patent law, the applicant is required to inform the Australian Patent Office of the results of any documentary searches conducted for the purpose of assessing the patentability of the invention and which are completed before the grant of the patent in Australia. The invention is that disclosed in the complete specification or a corresponding application outside Australia. Only the results of searches conducted by or for a foreign patent office are required.

What must be submitted

Compliance requires lodgement of the following:

- (i) A copy of any European Patent Office Search Report and any UK Patent Office Search Report. Alternatively, a list of the documents cited with the symbols (eg X, Y or A) used by the EU and UK Patent Office to indicate the relevance of the documents can be submitted.
- (ii) A list of the documents cited by any other foreign patent office, such as the US PTO. It is not necessary to refer in this list to a document referred to in a previously submitted list.

An exemption applies to an ISR, IPER, ISO or IPRP of a PCT application used to produce the Australian application.

All documents located in a search should be identified, both relevant and non-relevant.

Please note the requirement to provide details of any searches conducted prior to grant of the patent is ongoing. Therefore, please continue to advise us of any new search results so that these can be reported to the Patent Office. When providing search results, please let us know the date the search was completed.

What does not need to be submitted

Copies of the documents are not required.

Deadline for compliance

The deadline for filing search results is the latest of:

- (i) 6 months after requesting examination; or
- (ii) 6 months after the search is completed.

Extension of time

The deadline of 6 months from completion of the search could conceivably be up to 6 months after the actual date of grant.

Extensions of time are available on payment of monthly extension fees up to three months after advertisement of acceptance. Extensions after this time can be difficult to obtain and costly.

Sanction for non-compliance

The sanction for non-compliance is a restriction on the allowability of post grant amendments where the effect of the amendment would be to make a claim valid over prior art that was not disclosed to the Australian Patent Office.



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To: Koestner Bertani LLP
Fax No: + 1 512 692 2529
From: Steven Wulff
Office: Melbourne Office
Date: 2 June, 2005
Re: Lockheed Martin Corporation
Australian Patent Application No. 2002222956
"System and method for locating and positioning an
ultrasonic signal generator for testing purposes"
Your Ref: 1017.P037AU
Our Ref: 2598410/SEW/GC
Pages: (7)

(Including this one)

If you do not receive all pages, please let us know
Phone +613 9254 2777 Fax +613 9254 2770

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Melbourne
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Brisbane
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In association with:
Davies Collison Cave Solicitors

31 May, 2005

*(Via Facsimile and
Confirmation Mail)*

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Your Ref: 1017.P037AU
Our Ref: 2598410/SEW/GC
Re: Lockheed Martin Corporation
Australian Patent Application No. 2002222956
"System and method for locating and positioning an ultrasonic
signal generator for testing purposes"

Dear Sirs,

A first official report has issued in respect of the above application and a copy is *enclosed*.

The initial period for responding to this and subsequent official reports has been set to expire on **4 April 2006**. The application may be accepted up to nine months after that date, however any response to an official report filed outside of the initial period is subject to substantial late fees calculated on a monthly basis. In any event, the final and inextensible deadline by which acceptance of the application must be secured is **4 January 2007**.

In relation to the note, when requesting examination of the present case, it was also requested that acceptance of the application be postponed until the final acceptance deadline to ensure that the applicant has an opportunity to amend. Unless you instruct us otherwise, we will withdraw the request for postponement of acceptance when filing a response to the official report.

Objection 1 can be overcome by filing a Notice of Entitlement, a draft of which is *enclosed*. Please check the details on the draft and let us know if they are incorrect.

Regarding objection 2, we assume you are familiar with the cited document as it was also cited in the International Search Report. We have therefore not considered the objection in detail, nor obtained a copy of the citation for review, and we would appreciate your instructions for dealing with the objection. Alternatively, we would be pleased to review the relevant

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Canberra

31 May, 2005

documents and offer our recommendations for overcoming the objection, if you instruct us to do so.

Objection 3 relates to the clarity of the terminology in claim 2 and appears to be self-explanatory. We have not considered this objection in detail and look forward to receiving your instructions for responding to it. Alternatively, please let us know if you would like us to review the specification and offer our recommendation for dealing with the objection.

When responding to the official report, we propose to review the specification and make amendments as necessary in order to place it in a form which is particularly suited to Australian practice.

Under recently enacted legislation, the applicant must now provide information concerning search results. We *enclose* a memorandum on this and ask that you provide us with known search results accordingly, at your earliest convenience.

Please let us have your instructions for responding to the official report at your earliest convenience. In the meantime, our invoice will be forwarded with the confirmation copy of this transmission. Please note that this includes an official fee component which was not changed in our Invoice 4385310.

Yours faithfully,
DAVIES COLLISON CAVE



Steven Wulff

Encl. Copy of the official report
Draft Notice of Entitlement
Invoice

04 April 2005

COPY



Australian Government

IP Australia

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TUESDAY 05 APR 2005

Your Ref: 2598410/KL

Examiner's first report on patent application no. 2002222956
by Lockheed Martin Corporation

Last proposed amendment no.

Dear Madam/Sir,

I am replying to the request for examination. I have based this report on the pamphlet. I have examined the application and I believe that there are lawful grounds of objection to the application. These grounds of objection are:

NOTE: There is a current postponement of acceptance in place. If you overcome all other objections before the expiration of that postponement, the Commissioner will only accept the application at that time if you have filed a clear and unambiguous statement requesting the withdrawal of that postponement. Otherwise, a further adverse report will be issued.

1. There is no Notice of Entitlement on file. You will need to file one because an application without a Notice of Entitlement cannot be accepted.
2. Claims 1, 12-14, 24-26 and 36-39 are not novel or inventive when compared with US 4817016 A (THOMPSON et al.) 28 March 1989, which was cited in the ISR. All of the features defined by these claims are disclosed by this document, therefore claims 1, 12-14, 24-26 and 36-39 cannot be considered either novel or inventive.
3. Claim 2 is not clear, as claim 1 defines the energy generator as generating sonic energy.

You have 21 months from the date of this report to overcome all my objection(s) otherwise your application will lapse.

You will need to pay a monthly fee for any response you file after 12 months from the date of the first report.

You will also need to pay any annual continuation fees that apply. These will normally be first due five years from the filing date. Please note however that earlier commencement dates apply for divisional applications.

Information about fees may be obtained by phoning 1300 651010.

Yours faithfully,

A handwritten signature in black ink, appearing to be 'Ag' or 'Agh', written in a cursive style.

ANDREA HADLEY
Patent Examination A
C3 - Electronics
Phone: (02) 6283 2222